



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Edh

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/509,462 07/20/00 BKAILY

G 9555.97USWO

023552
MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS MN 55402-0903

HM12/1107

EXAMINER

FESELEV, E

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

8
11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/509,116/2

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/9/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-40 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-40 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1623

Claims 24-25, 35 and 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the reasons set forth in the Office Action of March 28, 2001.

Applicant's arguments filed October 9, 2001 have been fully considered but they are not persuasive. Applicant contends that the specification discloses inhibition of human lymphocyte proliferation. However, the specification fails to show decrease in proliferation of any type of cancer or tumor cells as encompassed by the instant claims.

Claims 10-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is encompassed by the term "preventing" (claim 11, 20, 22, 33, 34, 37, 38 and 40) i.e. it is not clear whether prevention was achieved for a period of days, months, years or whether permanent prevention was achieved.

Claims 11, 14 and 16 are substantial duplicates.

Claims 10 and 14-27 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claims. See MPEP § 608.01(n).

There is no antecedent basis in claim 1 for the compound in claim 28.

There is no antecedent basis in claim 8 for the compound in claim 31.

Art Unit: 1623

Claim 29 is improper in that it depends both from claim 2 and the Figures.

Applicant's arguments filed October 9, 2001 have been fully considered but they are not persuasive.

The specification fails to define the term "prevention". Therefore it cannot be ascertained if applicant intended the use the claimed compounds as a vaccine.

Note that the amendment presented does not include cancellation of claims 10, 13, 14-17, 19, 21, 23 and 25-27 as stated by applicant.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Calixto et al (Br. J. Pharmacol. (1988), 94 1133-1142) or Neves et al (European Journal of Pharmacology, 243 (1993) 213-219) for the reasons set forth in the Office Action of March 28, 2001.

Applicant's arguments filed October 9, 2001 have been fully considered but they are not persuasive.

Applicants contend that the art of record teaches the presence of a crude compound fraction called MV8612 but do not disclose isolation and structure of the compound. This argument has not been found persuasive. The structure of the compound is an inherent characteristic of the compound. Further, the instant claims are not limited to the pure form of the claimed compound.

Art Unit: 1623

Also, the instant method claims fail to specify a host to be treated and encompass prevention i.e. the instant method claims encompass the treatment of a healthy host or a host having any condition.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (703) 308-4616. The examiner can normally be reached on weekdays from 9.30 a.m. to 6.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Application/Control Number: 09/509462

Page 5

Art Unit: 1623

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

PRIMARY
GROUP 1800

elli peselev
ELLI PESELEV
PRIMARY EXAMINER
GROUP 1800